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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

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ADVANTEK MARKETING, INC., ) CASE NO. CV 16-3061-R

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Plaintiff, ) ORDER GRANTING DEFENDANT'S  
13 ) MOTION FOR JUDGMENT ON THE  
14 ) PLEADINGS

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v.

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SHANGHAI WALK-LONG TOOLS CO., et al.,

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Defendants.

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Before the Court is Defendant's Motion for Judgment on the Pleadings (Dkt. No. 24), which was filed on August 31, 2016. This Court took the matter under submission on October 4, 2016.

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"After the pleadings are closed but within such time as not to delay the trial, any party may move for judgment on the pleadings." Fed. R. Civ. P. 12(c). A court may grant a motion for judgment on the pleadings when, accepting all factual allegations as true, there is no issue of material fact, and the moving party is entitled to judgment as a matter of law. Motions under 12(b) and 12(c) of the Federal Rules of Civil Procedure are "functionally identical." *Dworkin v. Hustler Magazine, Inc.*, 867 F.2d 1188, 1192 (9th Cir. 1986).

1 Dismissal under Federal Rule of Civil Procedure 12(b)(6) is proper only when a complaint  
 2 exhibits either a “(1) lack of a cognizable legal theory or (2) the absence of sufficient facts alleged  
 3 under a cognizable legal theory.” *Balistreri v. Pacifica Police Dept.*, 901 F.2d 696, 699 (9th Cir.  
 4 1988). Under the heightened pleading standards of *Twombly* and *Iqbal*, a plaintiff must allege  
 5 “enough facts to state a claim to relief that is plausible on its face,” so that the defendant receives  
 6 “fair notice of what the...claim is and the grounds upon which it rests.” *Twombly*, 550 U.S. at  
 7 570. The Plaintiff must plead factual content that allows the court to draw the reasonable  
 8 inference that the defendant is liable for the misconduct alleged. *Iqbal*, 556 U.S. at 678. The  
 9 court will not accept “threadbare recitals of the elements of a cause of action, supported by mere  
 10 conclusory statements. . . .” *Id.*

11 Defendant’s Motion is based entirely on the doctrine of prosecution history estoppel.  
 12 Plaintiff opposes the Motion by arguing that Defendant’s argument is inappropriate at this stage of  
 13 the litigation and that even if it was, Defendants’ have not met their burden of proving the  
 14 elements of prosecution history estoppel.

15 Courts may take judicial notice of facts that are “capable of accurate and ready  
 16 determination by resort to sources whose accuracy cannot reasonably be questioned.” Fed. R.  
 17 Evid. 201(b)(2). It is generally accepted that records from the United States Patent and Trademark  
 18 Office (“USPTO”) may be judicially noticed. *Anderson v. Kimberly-Clark Corp.*, 5700 Fed.  
 19 App’x 927, 932 n.3 (9th Cir. 2014). Courts may rely on information subject to judicial notice  
 20 when deciding a Rule 12 motion. *Id.* at 932. Defendant has offered the relevant patent’s  
 21 prosecution history from the USPTO website for judicial notice. Plaintiff does not dispute these  
 22 records. Defendant’s request for judicial notice is GRANTED.

23 Given that Courts may rely on facts subject to judicial notice in deciding a motion to  
 24 dismiss, it is appropriate for the Court to consider the applicability of the prosecution history in  
 25 this matter. While the 12(b)(6) and pleading standards will apply, this Court may consider the  
 26 prosecution history of U.S. Patent No. D715,006 (“‘006 Patent”). Success under the doctrine of  
 27 prosecution history estoppel “turns on the answers to three questions (1) whether there was a  
 28 surrender; (2) whether it was for reasons of patentability; and (3) whether the accused design is

1 within the scope of surrender.” *Pacific Coast Marine Windshields v. Malibu Boats, LLC*, 739 F.3d  
 2 694, 702 (Fed. Cir. 2014).

3 Plaintiff designed a pet kennel called the “Pet Gazebo” for which it received the ‘006  
 4 Patent. During the course of applying for the patent, Plaintiff replied to a restriction requirement  
 5 from the Patent and Trademark Office. Plaintiff now claims that the Defendants are infringing the  
 6 ‘006 Patent by producing and selling a pet kennel similar to the Pet Gazebo.

7 Defendant argues that Plaintiff’s decision to elect the iteration of the Pet Gazebo without a  
 8 cover in response to the USPTO’s restriction requirement constitutes a surrender. Plaintiff  
 9 submitted two different design drawings to the USPTO and was forced to choose one of the two. It  
 10 chose the skeletal shell of the Pet Gazebo rather than a kennel with a cover on it. In choosing one  
 11 of two drawings in response to a restriction requirement, Plaintiff surrendered that claim. By  
 12 cancelling figures showing a gazebo with a cover, “the applicant surrendered such designs and  
 13 conceded that the claim was limited to what the remaining figure showed[.]” *Id.* at 703.

14 Next, Defendant argues that the surrender was made for the purpose of patentability. Like  
 15 the surrender at issue in *Pacific Coast Marine Windshields* which was not made for the purpose of  
 16 avoiding prior art or other “reasons of patentability,” here, the surrender was made for the purpose  
 17 of responding to the restriction requirement and securing the patent. Plaintiff argues that this is a  
 18 question of fact, however, there is no such question for a design patent. Design patents, by their  
 19 nature may only include a single claim. *Id.* The USPTO responded to Plaintiff’s designs by  
 20 requiring it to restrict the claimed patents to either “a kennel without a cover” or “a kennel with a  
 21 cover.” This was labeled a restriction *requirement* by the examiner and is thus clear that in order  
 22 to receive the patent, Plaintiff had to surrender one of the claims. There was no reason to  
 23 surrender the proposed kennel with a cover other than to secure a patent.

24 Finally, Defendant must prove that the accused product is within the scope of surrender.  
 25 Prosecution history estoppel “requires an examination of the subject matter surrendered by the  
 26 narrowing amendment.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S.  
 27 722, 737 (2002). Such an examination in this case reveals that the narrowing amendment  
 28 surrendered a kennel with a cover. Here, Defendant has produced exactly that, a dog kennel in the

1 shape of a gazebo with a cover on it. Even on a Motion for Judgment on the Pleadings, taking all  
2 factual allegations as true, this Court can determine that the allegedly infringing product is exactly  
3 the same as the design forfeited by Plaintiffs. Plaintiff provided the description and image of  
4 Defendant's product. Plaintiff does not dispute the diagrams and descriptions in the prosecution  
5 history. On this information alone, the Court can determine that the scope of the surrender  
6 encompasses Defendant's product. This case differs from the decision in *Pacific* where the  
7 accused design and fell within an unclaimed range of the surrendered designs because here the  
8 kennel produced by Defendant is not within an unclaimed range of the narrowing amendment, it is  
9 the exact same as the design surrendered by Plaintiff.

10 After considering all the factual allegations made by Plaintiff as true, Defendant is entitled  
11 to judgment as a matter of law. Plaintiff's ordinary observer arguments are exactly the types of  
12 infringement analyses which are barred by the doctrine of prosecution history estoppel. Because  
13 this Court has found that the doctrine applies, it need not consider them.

14 **IT IS HEREBY ORDERED** that Defendant's Motion for Judgment on the Pleadings  
15 (Dkt. No. 24) is GRANTED.

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17 Dated: November 3, 2016.  
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MANUEL L. REAL  
UNITED STATES DISTRICT JUDGE